

REMARKS

19
Claims 11-16 and 33-61 are pending in the present application. In the Office Action, claims 11-16 and 33-41 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,587,034. In the interest of expediency, Applicant has included herein a terminal disclaimer and respectfully requests that the Examiner's rejection of claim 11-16 and 33-41 be withdrawn. However, it will be appreciated that the filing of the terminal disclaimer to obviate the Examiner's rejection is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. vs. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed Cir. 1991). See, e.g., MPEP §804.03.

In the Office Action, claims 11-16, 33-37, and 41-61 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubler, et al (U.S. Patent No. 5,726,984) in view of Buss, et al (U.S. Patent No. 5,539,395) and in view of what is known in the art of paging technology. Claims 38-40 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kubler in view of Buss and further in view of Weitzen, et al (U.S. Patent No. 5,107,259). The Examiner's rejections are respectfully traversed.

Paging messages may be sent to wireless computer terminals via a wireless data communications system, which may provide a sophisticated level of data communication that enables the user of a mobile terminal to manually enter data via a keyboard for communication to a central processor. However, in many cases it is impractical to provide a sophisticated mobile terminal unit to every employee because of cost considerations. Moreover, it is often inconvenient to require a user to carry about a bulky terminal when only limited message communications are required for the particular user to carry out his or her duties. See Patent

Application, pg. 2-3. Thus, the present invention provides highly portable and simplified data communication devices for use in conjunction with a wireless data communication.

With regard to independent claims 11, 33, and 41, Applicants describe and claim a mobile scanning unit for use in connection with a radio data communications system. The mobile scanning unit includes a scanner for scanning optical code, a radio module for data communications, and a display. The scanner also includes an annunciator. The mobile scanning unit described and claimed in claim 11 includes a programmed controller for controlling the scanner and receiving data from the scanner. The programmed controller is configured to receive alphanumeric paging messages using the data communications system, to provide said alphanumeric paging messages to the display, and to operate the annunciator to signal receipt of a paging message. The radio module described and claimed in claim 33 is programmed to receive alphanumeric paging messages, to provide the alphanumeric paging messages to the display, and to engage the annunciator to signal receipt of a paging message.

To establish a *prima facie* case that the present invention is obvious in view of the cited references, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the

prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142.

Kubler describes a packet-based hierarchical communications system. In particular, Kubler is directed to a method and apparatus wherein voice and data communication are provided among devices within wireless portions of a communication network and stationary devices within hardware portions of the network. In various embodiments of the invention described by Kubler, a conventional code reader may be included. However, as admitted by the Examiner at paragraph 2 on page 7 of the present Office Action, the conventional code reader described by Kubler does not include an annunciator. Moreover, the conventional code reader described by Kubler is not programmed to receive alphanumeric paging messages using the communications system, and Kubler provides no suggestion or motivation for modifying the conventional code reader so that it may receive alphanumeric paging messages using the communications system. At least in part because the code reader described by Kubler is not programmed to receive alphanumeric paging messages using the communications system, Kubler also does not describe, suggest, or provide any motivation for providing alphanumeric paging messages to a display in the code reader. Accordingly, the code reader described by Kubler is not programmed to engage an annunciator to signal receipt of a paging message.

The Examiner relies on Buss to teach an annunciator that is used to signal receipt of a paging message. Buss is directed to providing a location dependent message to a paging device including an annunciator. At paragraph 4 on page 7 of the Office Action, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the annunciator described by Buss into the conventional code reader described in Kubler to signal receipt of a paging message by Kubler's device, *i.e.* the conventional code reader, for the purpose of alerting a user of a received message. Applicants respectfully disagree for at least the following reasons.

First, neither Buss nor Kubler provide any suggestion or motivation for modifying the prior art to arrive at Applicants' claimed invention. In particular, neither Buss nor Kubler provide any suggestion or motivation for incorporating an annunciator into a conventional code reader or scanner. At paragraph 4 on page 7 of the Office Action, the Examiner alleges that it would have been obvious to one of ordinary skill in the art to use an annunciator for the purpose of alerting a user to a received message. However, the Examiner provides no support for this conclusory statement. A recent Federal Circuit case emphasizes that, in an obviousness situation, any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Second, as admitted by the Examiner at paragraph 1 on page 8 of the Office Action, Buss and Kubler are both completely silent with regard to a scanner, or a code reader, that is programmed to receive alphanumeric paging messages using the communications system and includes an annunciator to signal receipt of an alphanumeric paging message. Since Buss is

concerned with providing location dependent messages to conventional paging devices, Buss provides no teaching or motivation to modify the prior art in the manner suggested by the Examiner, *i.e.* to modify the conventional code reader described by Kubler to receive alphanumeric paging messages using the communications system and to include an annunciator to signal receipt of an alphanumeric paging message. Nevertheless, at paragraph 2 on page 8 of the Office Action, the Examiner alleges that one skilled in the art would recognize that programming a controller to receive alphanumeric paging messages is well known and it would therefore be obvious to use a controller programmed to receive alphanumeric paging messages in Kubler and Buss's device. The Examiner does not provide any support for this conclusory statement and Applicants respectfully submit that conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002), 1434-35.

In light of the above arguments, Applicants respectfully submit that the Examiner is using Applicants' disclosure as a guide for selecting bits and pieces from various references to arrive at Applicants' claimed invention. Applicants submit that this is improper because it is the claimed invention, as a whole, that must be considered for purposes of determining obviousness. A mere selection of various bits and pieces of the claimed invention from various sources of prior art does not render a claimed invention obvious, unless there is a suggestion or motivation in the prior art for the claimed invention, when considered as a whole. A finding of obviousness under 35 U.S.C. § 103 requires a determination of the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to

one of ordinary skill in the art at the time the invention was made. *Graham v. John Deere Co.*, 148 USPQ 459 (U.S. S.Ct. 1966).

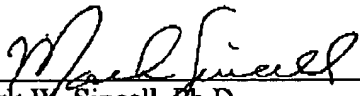
With regard to claims 38-40, which depend from claim 33, the Examiner relies on Weitzen to teach a display that includes a first screen having a first resolution and a second screen having a second resolution, wherein the second resolution is higher than the first resolution. However, Weitzen does not remedy the aforementioned fundamental deficiencies of the primary and secondary references. Thus, claims 38-40 are patentable over the cited references for at least the reasons discussed above in conjunction with independent claim 33.

For at least the aforementioned reasons, Applicants respectfully submit that there is no suggestion or motivation in the prior art for the claimed invention, when considered as a whole. Furthermore, there is no support in the prior art of record for the Examiner's conclusory statements regarding common knowledge of persons of ordinary skill in the art. Thus, applicants respectfully submit that independent claims 11, 33, 41, and all claims depending therefrom, are not obvious over Kubler in view of Buss and, with regard to dependent claims 38-40, further in view of Weitzen.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: 1/9/04


Mark W. Sincell, Ph.D.
Reg. No. 52,226
Williams Morgan & Amerson, P.C.
10333 Richmond Avenue, Suite 1100
Houston, TX 77042
(713) 934-7000
(713) 934-7011 (Fax)

AGENT FOR APPLICANTS